

REMARKS

Responsive to the Office Action mailed 22 April 2008 and with an extension of time of THREE MONTHS, the present paper is timely filed on or before 22 October 2008. By the present paper, claims 2, 3, 8, and 9 are cancelled and claims 1 and 7 are amended. Accordingly, claims 1, 2, and 7, and 10 - 13 are in the Application.

Entry of the claim amendments and reconsideration of the Application are respectfully requested.

The Claim Amendments:

Claims 1 and 7 are amended to recite the acrylic monomers that are the polymeric monomer components recited in claim 2, now cancelled. Support for the claim amendments can be found, for example, in the claims as filed.

Applicants respectfully submit that the claim amendments do not introduce new matter into the Application.

Claim Rejections Under 35 U.S.C. § 103:

Claims 1, 3-5, 7, 9, and 10 were rejected under 35 U.S.C. § 103 as allegedly obvious over Shih et al., United States Patent 6,153,288 (Shih et al.). Applicants respectfully traverse.

Turning first to claims 1 and 7, The Office acknowledges that Shih et al. does not disclose copolymers having units derived from acrylic esters and the Office does not argue any basis for modification of the EVA emulsion polymers employed by Shih et al.. Accordingly, Applicants respectfully submit that the rejection of claims 1 and 7 is improper and should be withdrawn.

Cancellation of claims 3 and 9 renders rejection of those claims moot.

Claims 4, 5, and 12 depend from claim 1 that Applicants respectfully submit contains patentable subject matter. Accordingly, claims 4, 5, and 12 likewise contain patentable subject matter and the rejection of these claims as

obvious over Shih et al should be withdrawn.

Claims 10, 11, and 13 depend from claim 7 that, Applicants respectfully submit, contains patentable subject matter. Accordingly, claims 10, 11, and 13 likewise contain patentable subject matter and the rejection of these claims should be withdrawn.

Claims 2 and 8 were rejected as allegedly obvious over Shih et al., *supra*, in view of Shiaonung Su, United States Patent 6,124,417 (Su). Because nothing in Su would have suggested to the skilled artisan of the day - seeking to develop a composition for dying, printing, or coating - to modify the EVA polymers disclosed by Shih et al. to include monomeric components of, e.g., butyl acrylate, with the reasonable expectation that a useful composition would result, Applicants respectfully traverse.

The Office acknowledges that the “ink receptive compositions” disclosed by Shih et do not include polymers having units derived from vinyl acetate and an ester of acrylic acid. Su discloses ink-jet printable water-activatable “constructions”, such as labels and tapes. The water activatable layer may include an acrylic polymer (Su at 1:19 and 2:35-54). The water-activatable and (in some embodiments) acrylate-containing layer is not tacky. But pressure sensitive adhesives are by their very nature tacky.

Applicants acknowledge that, during examination, the Office is obliged to interpret claims as broadly as reasonably possible. But this obligation does not convey license to completely ignore limitations in a claim. The acrylate-containing polymers of Applicants’ inventive compositions are - by the very words of the claim - of the pressure-sensitive adhesive type. Su, which discloses non-tacky acrylate polymers, cannot possibly suggest acrylate polymers that are pressure-sensitive adhesives and hence tacky. Shih et al., alone or in combination with Su, thus does not teach or suggest all of the limitations of Applicants’

claims 1 and 7. Accordingly, Applicants respectfully submit that the rejection of the subject matter of claims 2 and 8 (now embodied in claims 1 and 7, respectively) is improper and should be withdrawn.

Claims 6 and 11 were rejected as allegedly obvious over Shih et al., *supra*, in view of Miyabayashi et al., published United States Patent Application 2001/0023266. Claim 6 depends from claim 1 and claim 11 depends from claim 7. As argued above, Applicants respectfully submit that claims 1 and 7 contain patentable subject matter. Accordingly, Applicants respectfully submit that claims 6 and 11 likewise contain patentable subject matter and that the rejection of claims 6 and 11 should be withdrawn.

Claims 1-2, 6, and 12 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Miyabayashi et al., published United States Patent Application 2001/0023266 (Miyabayashi et al.). Because modification of Miyabayashi et al. to arrive at Applicants inventive composition is counterintuitive and contrary to the apparent principal of operation of the putative invention of Miyabayashi et al., and further because the Office offers no discussion whatsoever for the conclusory statement that the amount of water-soluble cationic polymer is “clearly” a “results-effective variable”, Applicants respectfully traverse.

The Office apparently ignores the element of Applicants’ claim 1 that the composition be formed by mixing the aqueous-emulsion type acrylic pressure sensitive adhesive with a cationic water-soluble polymer. Any mixing in

Miyabayashi et al. is at the end-use point of recording (a permanent image). At that point, the composition of Miyabayashi et al. is done, incapable of further function, for example for dying. The skilled artisan of the day, reading Miyabayashi et al. would not have come to the idea of making a useful printing composition by starting with the finished end product of Miyabayashi et al. Furthermore, Miyabayashi et al. recites a laundry list of monomer components

that can be used to make the polymer of the fine polymer particles therein disclosed. The resulting polymers belong to a variety of classes (Miyabayashi et al. at [0051] & [0052]). The Office has not pointed to any suggestion or motivation for selecting only those polymers meeting the limitations of Applicants' claims out of the tremendous number of possibilities disclosed by Miyabayashi et al. The "genus" is simple to huge to suggest the handful of species recited in Applicants' claims 1 and 7.

The conclusion that the percentage of water-soluble cationic polymer is a results-affecting variable, and hence ripe for routine optimization, is not, based on the record, capable of instant and unquestionable demonstration as being well known. Applicants respectfully submit that they are entitled to at least such a reasoned statement as would amount to 'substantial evidence' to support the Office's conclusion. Such reasoned statement is respectfully requested. *See* M.P.E.P. § 2144.03.

For the foregoing reasons, Applicants respectfully submit that the rejection of claims 1 and 2 (now combined in claim 1) and 6 and 12 is improper and should be withdrawn.

Claims 7 and 13 were rejected under 35 U.S.C. § 103(a) as allegedly anticipated by Miyabayashi et al., *supra*, in view of Goldberg et al., United States Patent 4,889,559 (Goldberg et al.). Applicants respectfully traverse.

The defects of Miyabayashi et al. are discussed above in Applicants' traversal of the obviousness rejection over Miyabayashi et al.. Applicants respectfully submit that nothing in Goldberg et al. cures the basic defects in the application of Miyabayashi et al. and that the rejection is improper and should be withdrawn.

Conclusion:

Based on the foregoing amendments and remarks, Applicants respectfully submit that the claims are now in condition for allowance, which allowance is earnestly solicited.